

Remarks

We have amended the claims to more particularly and distinctly define the subject matter of the invention and to better distinguish the invention from the prior art of record. Specifically, we added a modifier to the original phrase 'risk areas' that defines those areas as 'categories of potential losses'. This distinction shows the difference between the Guheen patent cited, which uses behaviour to create a user profile, and our patent in which we ask the user to respond to specific questions grouped by risk areas to create a risk profile. Nowhere in the Guheen patent does the inventor cite the use of a questionnaire, groupings of risk areas, nor the creation of a risk profile. It was our intent to clarify this distinction by inserting the phrase 'categories of potential losses. To further assist in clarifying the distinction, we also included the phrase 'at least as to categories of said potential losses.

Extracts from June 23, 2005 remarks

The claims have been amended to more particularly and distinctly define the subject matter of the invention and to better distinguish from the prior art of record. No new matter is presented. The number of claims is unchanged.

The claims were rejected as anticipated under 35 U.S.C. §102 by US Pat. 6,519,571 – Guheen. Reconsideration is requested. The Guheen patent fails to meet applicant's invention claimed as a whole. Whereas Guheen does not meet all the aspects claimed, there is no bar to a patent presented under 35 U.S.C. §§102 or 103.

The claimed invention is a risk assessment tool whereby a service provider can assess the exposure of subjects, typically business entities, to certain risks of loss. In the preferred embodiments, the invention is directed to assessing the risks of losses of modern businesses, particularly losses that result from ignorance of arcane rules and recurrent pitfalls of the unwary. Applicant's has invented the technique of composing an "expert" assessment process having an inquiry/response interaction with the user, designed to detect and assess exposure to recurrent pitfalls that have legal, contractual and/or data processing aspects.

There is nothing disclosed or suggested in the Guheen reference that would enable a person of ordinary skill to practice applicant's claimed methods for assessing risk of loss, or that would lead routinely to modifying Guheen's disclosed techniques to strike out in directions other than those that Guheen has specifically disclosed. Guheen does not anticipate the claims because Guheen does not meet all the elements of applicant's claimed invention. See MPEP 2131. The differences between the invention and the prior art are such that the

invention claimed as a whole is not shown to be obvious. Guheen has different objects, achieves them in different ways and produces a different result, including the nature and form of output as compared to the claimed invention.

Applicant uses a composed set of pointed questions to elicit responses that enable assessment of the risk of losses. Claim 1 as amended states particularly and distinctly states that the assessment is one of potential losses. Dependent claims 5-7 particularly define sets of such losses in successively different claim scope. The categories stated in the dependent claims are losses associated with computational deficiency, denial of service, security breach, violation of legal regulations, tort, contractual breach, insufficient capacity to meet contractual requirements, breach of commitment of confidentiality, violation of intellectual property rights, and/or failure to adhere to multi-jurisdictional differences in regulation.

The claimed invention may be applied to the assessment of risk of losses that are potentially insurable, rendering the technique useful to providers of business insurance. The claimed technique is also useful as a business assessment technique in evaluations, or as a self-assessment technique for businesses that are interested in tightening up their operations proactively. However, the point is that the invention assesses risk of loss.

Dependent claims 2-4 and 8-10 particularly state that the method is practiced using a set of expert inquiries to process data respecting the user (or subject being assessed) so as to determine exposure to such losses by pointed expert inquiries. The responses of a user, as well as the collected responses of many users, can populate a database to enable improved processing and perhaps to improve the accuracy with which losses are related by the system to particular user situations as identified by the users' responses.

The cited patent to Guheen lacks a similar teaching or suggestion. In Guheen, an interface is to be produced so as to assist data processing interactions between a user and a set of data processing services. Guheen employs a database to represent the user, but that is where similarities between applicant's claimed invention and Guheen substantially ends.